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**JAN 13 2004**

|                                   |   |                                 |
|-----------------------------------|---|---------------------------------|
| In re Application of              | : | <b>OFFICE OF PETITIONS</b>      |
| David Chown                       | : |                                 |
| Application No. 10/617,113        | : | <b>DECISION ON PETITION</b>     |
| Filed: July 10, 2003              | : | <b>UNDER 37 C.F.R. §1.47(b)</b> |
| Attorney Docket No. 871-011413-   | : |                                 |
| US/30020606 US                    | : |                                 |
| Title: OPTOELECTRONIC MODULE WITH | : |                                 |
| INTEGRATED LOOP-BACK CAPABILITY   | : |                                 |

This is in response to the petition under 37 CFR §1.47(b)<sup>1</sup>, filed September 8, 2003.

The above-identified application was filed on July 10, 2003. On September 8, 2003, applicant filed the instant petition (and fee), the surcharge associated with the late filing of an oath or declaration<sup>2</sup>, and a declaration executed by an officer of the purported assignee. Accompanying the petition was a statement from the petitioner, a declaration of facts, copies of two letters, an employment agreement, and an invention disclosure form.

Petitioner has met requirements (1) – (3) and (6) above.

Regarding the fourth requirement above, Petitioner has not submitted adequate proof that diligent efforts have been made to locate the non-signing inventor. *As petitioner has set forth that the non-signing joint inventor cannot be found or reached, petitioner is required to establish that a diligent effort was made to locate the non-signing inventor.* There is no indication that Rule 47 applicant attempted to verify non-signing inventor Chown's address or to determine his

<sup>1</sup> A grantable petition under 37 CFR §1.47(b) requires:

- (1) The petition fee;
- (2) a surcharge if the petition was not filed at the time of filing of the application;
- (3) a statement of the last known address of each of the non-signing inventors;
- (4) proof that diligent efforts have been made to locate the non-signing inventor
- (5) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (6) proof of irreparable damage, and;
- (7) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 CFR §1.63.

<sup>2</sup> The surcharge has been charged to petitioner's Deposit Account, as authorized in the petition.

forwarding address and to send the application papers to that address for consideration by the inventor<sup>3</sup>.

Petitioner has not submitted adequate proof that diligent efforts have been made to locate the non-signing inventors. Petitioner has made no effort to try to locate the inventor. No mention is made as to any search done for the non-signing inventor. If attempts to obtain a forwarding address or to locate the non-signing inventor by other means such as through E-mail, telephone, or the Internet fail, then applicant will have provided the necessary proof required under 37 C.F.R. §1.47 that the inventor cannot be reached. Details of the efforts to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details.

Applicant should submit documentary evidence such as the results of an E-mail or Internet search. It is important that the statement contain facts as opposed to conclusions<sup>4</sup>.

Regarding the fifth requirement above, petitioner has not established that that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application. Although an invention disclosure form and an employment agreement have been submitted, it is noted that the former is not executed. As for the later, the agreement specifically limits the scope of the intellectual property to that which arises out of "work carried out during the course of my employment<sup>5</sup>" and "ideas or work products produced by me during the course of my Agilent Technologies employment<sup>6</sup>." Petitioner has not established that the instant invention arose out of work carried out during the course of the non-signing joint inventor's employment.

Regarding the seventh requirement above, the declaration has been executed by "Dr. James Lenney," with the title of "Legal Department, Agilent Technologies UK Limited." With this, the rule 47(b) applicant has attempted to make the required oath or declaration. The declaration must state the relationship of the person, making the oath or declaration, to the inventor, and upon information and belief, the facts which the inventor is required to state. Where a corporation is the 47(b) applicant, an officer thereof should normally sign the necessary oath or declaration. Regardless, the title or position of the person signing must be stated. As such, Dr. James Lenney should give his title or position, as he is signing on behalf of a corporation<sup>7</sup>.

As such, the petition under 37 C.F.R. §1.47(b) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

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<sup>3</sup> See MPEP 409.03(d).

<sup>4</sup> See MPEP 409.03(d).

<sup>5</sup> Confidentiality Agreement, "Ownership of Rights" subsection.

<sup>6</sup> Confidentiality Agreement, "Exploitation" subsection.

<sup>7</sup> See 409.03(b).

On renewed petition, the petitioner should provide proof of either a diligent search or that the non-signing inventor refused to cooperate after having been provided with a complete copy of the application, reveal the last known address of the non-signing inventor, a declaration that has been properly executed by a corporate officer, and either a copy of the employment agreement or an assignment document or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would, by the weight of the authority, award title to the invention to the Rule 47(b) applicant.

The reply to this letter may be submitted by mail<sup>8</sup>, hand-delivery<sup>9</sup>, or facsimile<sup>10</sup>.

**The application file will be retained in the Office of Petitions for two (2) months.**

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.



Paul Shanowski  
Attorney  
Office of Petitions  
United States Patent and Trademark Office

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<sup>8</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

<sup>9</sup> Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202

<sup>10</sup> (703) 872-9306.